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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,128	10/09/2001	John F. Pavley	1509C/P161	5677

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EXAMINER

SAX, STEVEN PAUL

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/973,128

Applicant(s)

PAVLEY ET AL.

Examiner

Steven P Sax

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. This application has been examined.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 2-18 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 6317141 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 3 of the present application pulls elements from claims 1-3 of the '141 patent, but is broader in that it leaves out the slide show feature and the specific screen and media types. Claim 2 of the present application brings in the specific screen and media types, as in claim 1 and 2 of the '141 patent. Claims 4-6 are identical in both. Claim 7 of the present application shows the same

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features just described for claims 2-3. Claims 8-11 in the application and '141 patent have the same features in both. Claim 12 of the present application brings in the slide show which is in claim 1 and 17 for example of the '141 patent. Claims 13-15 of the present application show the same features described for claims 2-3.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (6072479) in view of Scott et al (5675752) and Foster (6211870).

6. Regarding claim 3, see Ogawa: Note the method for editing heterogeneous media objects in the digital imaging device - the representation of each is displayed on the screen (Abstract, Figures 2, 7, 12, see also Figure 5 for example, column 8 lines 1-

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50), enabling a user to randomly select a particular media object to edit (column 2 lines 40-68, column 3 lines 20-68). User input may be by mouse or key strokes, and specialized editing screens are invoked for each media type, and each editing screen operates in a similar fashion and has discrete cursor locations (column 4 lines 29-68, column 5 lines 15-60). Although Ogawa does show the distinguishing of the media types, the specific details of the specialized screens for the different types are limited. But the distinguishing is done for efficient and easy to use media editing. Furthermore, see Scott et al: the Abstract, Figures 2, 3, 6, 11A-B, 15A, 22B, 22C, 23E, 25, 26, 28, column 4 lines 1-24, column 8 lines 15-68, column 9 lines 1-20 (note specialized display screens that nevertheless operate in a similar and linked fashion), column 10 lines 12-40, column 11 lines 25-50, column 13 lines 1-27, column 15 lines 44-62, column 16 lines 35-49, column 19 lines 47-68, column 20 lines 41-68. Note the specific details of distinguishing the specialized screens for different editing features and object types in a media editing system. It would have been obvious to a person with ordinary skill in the art to incorporate this detailed specialized screen feature in the media editing system of Ogawa, because it would provide convenient and easy to use media editing in a media editing system that edits and differentiates between different media types using various screens. Neither Ogawa nor Scott et al specifically show how the device is handheld, but do show convenient user manipulation of the screens. Furthermore, Foster shows a handheld device for convenient user manipulation of the screens (Figures 9-10, column 4 lines 25-53). It would have been obvious to a person with ordinary skill in the art to

have this in Ogawa, especially as modified by Scott et al, because it would allow convenient user manipulation of the screens.

7. Regarding claim 2, the media types include still image, sequential, and text (as brought out in the combination with Scott et al in paragraph 6, see again Figures 2, 3, 6, 11A-B, 15A, 16, 22C).

8. Regarding claim 4, each editing screen operates in a similar fashion and has discrete cursor locations which the user navigates using navigation control (Ogawa column 4 lines 29-68, column 5 lines 15-60).

9. Regarding claim 5, real time preview may be applied (Ogawa column 9 lines 33-68, column 10 lines 29-45).

10. Regarding claim 6, thumbnail icons are displayed representing the media objects (Ogawa Figure 7 for example and column 11 lines 5-15).

11. Claims 7-11 show the same features as claims 3, 2, 4-6 respectively, and are rejected for the same reasons.

12. Regarding claim 12, note the slide show (Ogawa Figure 11, column 12 lines 25-55).

13. Claims 13-15 show the same features as claims 3 and 2 with the slide show feature of claim 12, and are rejected for the same reasons as those claims

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven P Sax whose telephone number is 703-305-9582. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEVEN SAX
PRIMARY EXAMINER